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10/566,267	01/30/2006	Yusuke Sakata	65836.00006	1678
32294 7590 05/23/2008 SQUIRE, SANDERS & DEMPSEY L.L.P. 8000 TOWERS CRESCENT DRIVE 14TH FLOOR VIENNA, VA 22182-6212				
EXAMINER				
KRUSE, DAVID H				
ART UNIT		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

10/566,267

## Applicant(s)

SAKATA ET AL.

## Examiner

David H. Kruse

## Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 1-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date 1/30/06/8/29/06
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of Group III, claims 10-21 directed to a method of breeding an ever flowering azalea, in the reply filed on 11 February 2008 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 1-9 are withdrawn from further consideration pursuant to 37 CFR § 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 11 February 2008.
3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR § 1.48(b) and by the fee required under 37 CFR § 1.17(i).

### ***Information Disclosure Statement***

4. The listing of references on pages 7-9 of the specification is not a proper information disclosure statement. 37 CFR § 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be

submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

5. The citation of document AA cited on the IDS filed 29 August 2006 has been corrected by the Examiner based on the information on page 7, lines 21-25 of the specification.
6. Those documents crossed out in the IDSs have not been considered because they are not in the English language, and Applicants had not provided a translation or a concise explanation of the relevance. See 37 CFR § 1.98 (a)(3)(i).

#### ***Specification***

7. The disclosure is objected to because of the following informalities: The reference to U.S. Patent 13073 on page 7 of the specification is incorrect and should refer to U. S. PP 13073. See also page 8, line 16.

Appropriate correction is required.

8. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR § 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The limitation "genotype HXXH Pg/pg Cy/cy/Dp/dp" lacks proper antecedent basis in the specification. In particular it is unclear where "H<sup>x</sup>H<sup>x</sup>" is defined in the specification.

#### ***Claim Objections***

9. Claims 20 and 21 are objected to because of the following informalities: Said claims are dependent upon non-elected claims. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

10. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 11 and 15-20 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

At claim 11, line 2, the limitation "preferably" renders the claim indefinite because it is unclear if the "gene" is required for the invention or not. Hence, the metes and bounds of the claim are unclear. Claims 15, 17 and 19 are also indefinite because they incorporate this limitation by way of their dependency.

Claim 20 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear where "H<sup>x</sup>H<sup>y</sup>" is defined in the specification; hence the metes and bounds of the claim are unclear.

The term "heat resistant" in claims 16-19 is a relative term which renders the claim indefinite. The term "heat resistant" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Applicants' definition on page 18 of the specification "high temperature and high humidity" is relative and does not provide a standard for ascertaining the requisite degree of the limitation.

Art Unit: 1638

12. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

13. Claim 20 is rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The instant specification fails to describe the limitation "H<sup>x</sup>H<sup>x</sup>". In addition, the limitation Pg/pg Cy/cy/Dp/dp implies an inheritance produced by a cross of plants having the genotypes PgCyDp x pgcydp, yet the specification discloses that Pg and Dp pigments are not co-existing (page 17, line 11).

Hence, it is unclear that Applicants were in possession of the invention as broadly claimed.

14. Claim 20 is rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The instant specification fails to teach how to make and use an azalea plant having the genotype "H<sup>x</sup>H<sup>x</sup>". In addition, the limitation Pg/pg Cy/cy/Dp/dp implies an inheritance produced by a cross of plants having the genotypes PgCyDp x pgcydp, yet the specification teaches that Pg and Dp pigments are not co-existing (page 17, line

Art Unit: 1638

11). Hence, it would have required undue trial and error experimentation by one of skill in the art at the time of Applicants' invention to make and use the invention as claimed.

***Claim Rejections - 35 USC § 102***

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

16. Claims 10-12, 14-19 and 21 rejected under 35 U.S.C. § 102(b) as being anticipated by Lee (U.S. Patent Plant 10,438).

Lee discloses a method of making a ever-flowering, heat resistant, evergreen azalea by crossing the *Rhododendron oldhamii* variety 'Fourth of July' as the male parent with an evergreen, non ever-flowering (one season flowering) azalea, variety 'Double Beauty' as the female parent to introduce into the one season flowering azalea a gene concerning ever-flowering property (see columns 2-3). Lee also discloses a novel azalea produced by the method; variety 'Conlea' which is evergreen, ever-flowering and heat resistant (see the Classification starting at column 3). The Examiner interprets the ability to grow well in the Independence, Louisiana region of the United States as meeting Applicants' definition of "heat resistant". Lee discloses that variety 'Fourth of July' is a perpetual bloomer and less hardy at zone 8 than at zone 7 (column 3, 3rd paragraph). Hence, it appears that the variety 'Fourth of July' is a less heat resistant azalea.

***Claim Rejections - 35 USC § 103***

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (U.S. Patent Plant 10,438) in view of Teruo Tamura, et al. (April 1989, "Hirado Tsutsuji no Saibai to Yurai", Kurume no Tsutsuji, Ashi Shobo, pages 153-162 (pages 157-158 in English)).

The teachings of Lee are outlined above.

Lee does not teach a method of breeding azaleas using a Hirado azalea or a Hirado Azalea Hybrid.

Teruo Tamura *et al* teach that Hirado azaleas had been used in the breeding of azaleas (page 157, 2<sup>nd</sup> paragraph).

It would have been *prima facie* obvious to one of ordinary skill in the art at the time of Applicants' invention that one could modify the teachings of Lee to use the azalea variety 'Fourth of July' to introduce into a one season flowering azalea a gene concerning ever-flowering property such as a Hirado azalea. The selection of a specific type of azalea to use in a breeding method would have been a design choice based on obvious characteristics such as growth habit and flower characteristics, in addition to the ever-flowering property taught by Lee.



***Conclusion***

19. No claims are allowed.
20. No prior art has been cited against claim 20 because the Examiner cannot search the limitation H<sup>x</sup>H<sup>x</sup>, and is unclear what the limitation Pg/pg Cy/cyDp/dp encompasses.
21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David H. Kruse, Ph.D. whose telephone number is (571) 272-0799. The examiner can normally be reached on Monday to Friday from 8:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached at (571) 272-0975. The central FAX number for official correspondence is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (571) 272-1600.

/David H Kruse/  
Primary Examiner, Art Unit 1638  
21 May 2008